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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,330	05/18/2006	Rune Freyer	2006-IP-019699 U1 USA	1607

20558 7590 09/10/2007  
SMITH IP SERVICES, P.C.  
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EXAMINER

ANDREWS, DAVID L

ART UNIT PAPER NUMBER

3672

MAIL DATE DELIVERY MODE

09/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/538,330	Applicant(s) FREYER, RUNE	
	Examiner David Andrews	Art Unit 3672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☒ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

The preliminary amendment filed 6/10/2005 has been entered.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Norway on 12/10/2002. It is noted, however, that applicant has not filed a certified copy of the NO 20025911 application as required by 35 U.S.C. 119(b).

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recess of claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 5 is objected to for a lack of antecedent basis of the limitation "the outer shell of the production tubing." Corrections are required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite that the opening in different dimensions may have "any configuration", the scope of which is indefinite and not distinct.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lembcke et al. (US 6,173,788). Lembcke et al. disclose a cable duct device in a swellable packer comprising: a swellable packer (12) provided with at least one through going opening (14) adapted to constitute a duct for a cable (16); wherein the opening encloses the cable prior to and after the swelling has occurred (col. 2, lines 51-54); wherein the opening may have any configuration (as disclosed the opening may have any configuration based on the cable shape and path through).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Clark (US 3,899,631). Clark discloses a cable duct device in a swellable packer comprising: a swellable packer (15) provided with at least one through going opening (20) adapted to constitute a duct for a cable (25); wherein the opening encloses the cable prior to and after the swelling has occurred (col. 2, lines 17-25); wherein the opening may have any configuration (as disclosed in col. 2, lines 17-27 any configuration could be accommodated).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke et al. in view of Wilderman (US 4,202,087). Lembcke et al. disclose all the limitations of this claim, as applied to claim 1, except for a recess within production tubing.

Wilderman discloses tubing with a longitudinal recess accommodating a cable (figure 3).

The tubing of Wilderman would be usable with the packer of Lembcke et al. as shown in figure 4. Although Lembcke et al. do not show a cable held on the inside of the packer, it is considered obvious to one of ordinary skill in the art that such an arrangement (as allowed by Lembcke et al., col. 48-51) could be made which would utilize the same sealing properties advantages as being held interior to the packer (col. 3, lines 10-14). It would have been obvious to one of ordinary skill in the art at the time of invention to use the tubing of Wilderman with the packer of Lembcke et al. in order to keep the cable(s) confined to a structure and not hanging within the interior of a wellbore annulus.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patel (US 7,222,676) discloses conduits with cables within outer

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grooves. Otten et al. (US 6,367,845) and Ferry et al. (US 5,217,071) disclose tubing with grooves to accommodate cables. Pranger (US 2,253,092) and Turley et al. (US 6,325,144) disclose packers with through-openings for cables.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Andrews whose telephone number is (571) 272-6558. The examiner can normally be reached on Monday-Thursday, 7:30am-5pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
David Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

DLA  
8/27/07